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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/934,479 | 08/23/2001 | Yoko Fujiwara | 018656-241 | 8426 |
| 7590 | 03/07/2006 | | EXAMINER | |
| Platon N. Mandros BURNS, DOANE, SWECKER & MATHIS, L.L.P. P.O. Box 1404 Alexandria, VA 22313-1404 | | | BRIER, JEFFERY A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2672 | |
| DATE MAILED: 03/07/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|---------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/934,479 | FUJIWARA ET AL. |
| | Examiner | Art Unit |
| | Jeffery A. Brier | 2672 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 23 December 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-34 and 37-47 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-34 and 37-47 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/23/2005 has been entered.

Response to Amendment

2. The amendment filed on 12/23/2005 has been entered.

Response to Argument

3. The arguments filed on 12/23/2005 concerning the 35 USC 101 rejection have been fully considered, however, after careful reconsideration of the claims practical application within the claims is not found. Independent claims 1, 9, 17, 27, 32, and 33 all claim "laying out the generated character code data within the at least one reconstructed documents block", however, this statement does not claim a practical application of the claimed functions. These claims are directed to abstract manipulations and propose an abstract result without providing for a practical application of the claimed process. These claims and their dependent claims are not limited to a practical application such as displaying the newly create layout image on a

display device, storing the newly create layout image in a computer readable memory for later presentation of the image to a user, printing the newly create layout image on a medium by the use of a computer controlled printer, etc. These are examples of a concrete, useful, and tangible results of a processed image.

Specification

4. The disclosure is objected to because of the following informalities: The amendment to the specification is unclear because the meaning of "photographic image area 20 containing a photographic image (including graphics)." is not clear since a photograph does not usually include graphics and the specification as whole does not teach photographs with graphics.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-34 and 37-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant amended claims 1, 9, 17, 27, 32, and 33 to claim "each portion of the document image data including at least one of character image data representing character images and photographic image data representing photographic images and graphic images". The paragraph on page 11 line 16 to page 12 line 2 that applicant amended originally stated "photographic image (including patterns)" and now has been amended to state "photographic image (including graphics)". The originally filed specification did not describe and does not convey to one of ordinary skill in the art that extracted photographic image data represents both photographic images (plural) and graphic images (plural) and further does not convey that extracted photographic image data represents both photographic image and graphic image. The specification only stated "Specifically, the area discriminating section 173 discriminates a character image area 18 containing a character image, and a photographic image area 20 containing a photographic image (including patterns)." In addition the amendment to the specification does not support the claim because the meaning of "photographic image area 20 containing a photographic image (including graphics)." means a photograph with graphics which is different than that is now claimed "photographic image data representing photographic images and graphic images".

Thus, the amendment to claims 1, 9, 17, 27, 32, and 33 claim more than that which was conveyed by applicants originally filed application.

Claims 1, 9, 17, 27, 32, and 33 were amended to claim "wherein all the document image data in the extracted at least one document block is less than all of the document data in the entire digital image", however, the specification discusses rescanning the entire image and then performing a detailed scan on the marked portion of the image, thus, the digital image does not occur until the detailed scan is performed which then creates a digital image of the same size that has the document image data and background image data. Thus, applicants claim amendment is not conveyed by applicants originally filed application.

Claims 32 and 33 claim "at least one circuit for" and the specification only describes one circuit 100 for performing the claimed process. The specification at page 21 states:

The components comprising the image processing device and the image processing method of the present invention may be realized by special hardware circuits or programmed computer. Furthermore, when the present invention is realized by programmed computer, the programs which operate the computer may be provided on a computer-readable recording medium (e.g., floppy disk, CD-ROM and the like). In this case a program recorded on a computer-readable recording medium normally is transferred to and recorded on a hard disk. The program also may be provided as independent application software. Furthermore, the program may be incorporated in the software of the computer as one function of the computer.

The specification at page 7 lines 7-11 states:

Image processing device 100 has a filing function for reading a document such as, for example, a newspaper, magazine or the like, extracting necessary document data from the obtained image data, and storing the data as an electronic file.

Figure 1 clearly shows one circuit for performing the claimed method, thus, hardware circuits mentioned on page 21 is directed to the circuits found in figure 1 which shows no more than one circuit for performing each claimed function.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-34 and 37-47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9, 17, 27, 32, and 33 were amended to claim "at least one of document image data and background image data" and to claim "at least one of character image data representing character images and photographic image data". In view of the following court cases discussing inclusive and alternative expressions and in light of applications specification the newly claimed limitation is unclear as to how applicant intended the phrase "at least one of" to limit "document image data and background image data" and to limit "character image data representing character images and photographic image data". In view of Super guide v Direct TV and IPXL v Amazon the claimed phrase is inclusive while the specification is manifesting at the most one document image data and background image data for each portion of data of the digital image and the specification is manifesting in the alternative each portion is character or photographic. The claimed "each portion" is indefinite since it is not consistently used in

the claim and it is not clear if it is a unit of measure or meant to be a broader claim limitation. The claimed "each portion of data of the digital image" (at lines 3-4 of claim 1 for example) is not definite since the extracted document block is a part of an entire digital image which manifests that the portion is smaller than the extracted block which implies that it would not have document image data and background image data and since the claim further claims (at lines 4-6 of claim 1 for example) each portion of the document image data which manifests a small portion which could not include character image data, photographic images and graphic images as claimed. Thus, the metes and bounds of claims 1-34 and 37-47 are unclear.

Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 69 USPQ2d 1865, 1878 (Fed. Cir. 2004). Page 1878 states:

We agree with DirecTV. The phrase "at least one of" precedes a series of categories of criteria, and the patentee used the term "and" to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that "an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term." William Strunk, Jr. & E. B. White, *The Elements of Style* 27 (4th ed. 2000). Thus, "[i]n spring, summer, or winter" means "in spring, in summer, or in winter." *Id.* Applying this grammatical principle here, the phrase "at least one of" modifies each member of the list, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category; that is, at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type.

IPXL Holdings LLC v. Amazon.com Inc., 72 USPQ2d 1469, 1480 (DC EVa 2004) makes a decision similar to SuperGuide. Page 1480 states:

The parties dispute whether "user defined transaction information" requires both a "user defined transaction" and a "user defined transaction parameter" as Amazon contends,

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or only one of either a "user defined transaction" or a "user defined transaction parameter," as IPXL contends. For the reasons set forth below, the Court finds that IPXL misreads both the plain words used in the claim as well as Federal Circuit precedent in arguing for its interpretation. In construing the very same language, the Federal Circuit construed "at least one of" to mean what Amazon has argued. The phrase "at least one of" precedes a series of categories of criteria, and the patentee used the term "and" to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that "an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term." William Strunk, Jr. & E.B. White, *The Elements of Style* 27 (4th ed. 2000).... Applying this grammatical principle here, the phrase "at least one of" modifies each member of the list, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category.... *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 886 [69 USPQ2d 1865] (Fed. Cir. 2004).

CAFC decision Brown v. 3M, 265 F.3d 1349, 60 USPQ2d 1375 (Fed. Cir. 2001)

This decision found that the term "or" in claim 16 in the *at least one of two-digit, three-digit, or four-digit year-date representations* phrase is to be read in the alternative when read in light of the specification. Page 1378 states:

The district court construed the word "or" in claim 16 as meaning that the apparatus was capable of converting "only two-digit, only three-digit, only four-digit, or any combination of two-, three-, and four-digit date-data." Slip op. at 9. We agree with this construction of the claim, for it is the plain reading of the claim text. These are not technical terms of art, and do not require elaborate interpretation. There is no basis in the specification or prosecution history for reading "or" as "and" — nor does Dr. Brown request such a reading.

Claims 1, 9, 17, 27, 32, and 33 all claim "laying out the generated character code data within the at least one reconstructed documents block", however, this statement does not clearly claim the function covered by this claim limitation. Thus, the metes and bounds of claims 1-34 and 37-47 are unclear.

Claims 42-47 claim the character code includes at least one font size, however, a single character code for one character of the document has one font size, thus, a claim to more than one font size is indefinite for failing to claim how a scanned character can have more than one font size in light of applications specification. Page 13 line 10 states the character code data of the document has font size not that a character code of a document character has more than one font size. This is also expressed on page 13 in the discussion step S204.

Claim Rejections - 35 USC § 101

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. Claims 1-34 and 37-47 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-34 and 37-47:

This application is directed to a useful, concrete, and tangible result, however, these claims are not. These claims are directed to abstract manipulations and proposing an abstract result without providing for a practical application of the claimed process. Claims 1, 9, 17, 27, 32, and 33 all claim "laying out the generated character code data within the at least one reconstructed documents block", however, this

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statement does not claim a practical application of the claimed functions. The CAFC clearly wrote in State Street at paragraph 4 *The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility.* These claims are not limited to a practical application such as displaying the newly create layout image on a display device, storing the newly create layout image in a computer readable memory for later presentation of the image to a user, printing the newly create layout image on a medium by the use of a computer controlled printer, etc. These are examples of a concrete, useful, and tangible results of a processed image. Applicants' specification at page 4 lines 13-23 states:

This image processing device also may be provided with file generation means for generating an electronic file storing the character code data laid out by the layout means.

This image processing device also may be provided with a printer for printing the character code data laid out by the layout means on a recording substrate.

This image processing device also may be provided with a reader for reading image data to be processed by optically reading an image of a document.

Applicants' specification at page 18 lines 6-13 states:

In step S216, the document data 34 (refer to FIG. 11) which has been completed by arranging the headline character code data 30, the body text character code data 32, and the photographic image area 20 within the rectangular vector data 26, are stored on hard disk 150 as an electronic file. The document data 34 also may be saved on a flexible disk or the like via the recording media drive 160.

Applicants' specification at page 20 lines 15 to page 21 line 2 states:

The image processing device also may have, in addition to the structure shown in FIG. 1, an interface for sending and receiving data between the image processing

device and other information devices. In this way a generated document data 34 (refer to FIG. 11) may be transmitted to another information device such as a computer, printer or the like.

The image processing device also may have, in addition to the structure shown in FIG. 1, a printer engine for printing data on recording substrate such as cut paper, OHP transparencies, roll paper and the like. In this way a generated document data 34 may be printed on recording substrate.

Thus, applicants specification describes practical application for the invention.

Dependent claims 6-8 and 14-16:

These dependent claims broadly claim "an electronic file storing the character code data", "a printer for printing the character code data", and "a reader for optically reading an image of a document" however, they do not claim the practical utility of the claimed functions. State Street Bank & Trust Co. v. Signature Financial Group Inc. (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). AT&T Corp. v. Excel Communications Inc. (CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in State Street:

Under Benson, this may have been a sufficient indicium of nonstatutory subject matter. However, after Diehr and Alappat , the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." Alappat , 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in

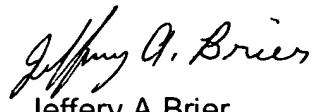
particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

11. A prior art rejection cannot be made because the metes and bounds of the claims are not definite and because the specification does not support the claims. Thus, an indication of allowability would be premature. *In re Steele*, 305 F.2d 859, 134 USPQ 292 (CCPA 1962) (it is improper to rely on speculative assumptions regarding the meaning of a claim and then base a rejection under 35 U.S.C. 103 on these assumptions).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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Jeffery A. Brier
Primary Examiner
Art Unit 2672